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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,343	12/19/2001	Tony Looper	VM6117	9618

7590 08/04/2003

Kim Diliberti
1430 Waukegan Road
McGaw Park, IL 60085

EXAMINER
SCHOPFER, KENNETH G

ART UNIT	PAPER NUMBER
3739	5

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/027,343	LOOPER ET AL.	
	Examiner	Art Unit	
	Kenneth G Schopfer	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 10, 11, 15, 16, 19-21, 24, 25, 29, 32, 36, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Freitas et al. (USPN 5486185).

3. Referring to claims 1, 4, 10, 11, 15, 16, 19-21, 24, 25, 29, 32, 36, and 37, Freitas et al. teach all of the limitations of these claims. Freitas et al. teach a reconfigurable surgical apparatus including a surgical instrument assembly with a hollow manipulation shaft with a prime mover received on the shaft, a coupler at the distal end of the shaft having a capture ledge, and an interchangeable surgical tool attachable to the coupler by releasably mating with the capture ledge (figures 4-8). The mating portion of the tool may be described as having a hooked shaped tine, a capture ledge, a lateral slot, an engagement ledge, and a shelf. The coupler may be described as having an anchor, an engagement ledge, and a shelf.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2, 3, 12, 13, 14, 17, 18, 26, 30, 31, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freitas et al. (USPN 5486185).

6. Referring to claims 2, 3, 12, 13, 14, 17, 18, 26, 30, 31, 38 and 39, Freitas et al. teach all of the limitations of these claims as described above except for the coupler including a lateral slot or a hook shaped tine. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of a coupler having a lateral slot or hook shaped tine as in the claims represents an unpatentable design choice over the coupler of Freitas et al. that would not change the functionality of the device.

7. Claims 5, 6, 8, 9, 22, 23, 27, 28, 33, 34, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freitas et al. (USPN 5486185) in view of Chien (GB 2227412A).

8. Referring to claims 5, 6, 8, 9, 22, 23, 27, 28, 33, 34, and 40-42, Freitas et al. teach all of the limitations of these claims as described above except for the tool having a frangible portion or notch. Chien teaches a surgical instrument having a notched frangible portion 3. It would have been obvious to one of ordinary skill in the art at the time of invention to include a frangible portion such as the notched portion in Chien to the device of Freitas et al. to ensure that the interchangeable tool of the device is not used again after it is removed from the coupler.

9. Claims 7 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freitas et al. (USPN 5486185) as applied to claims 2 and 30 above, and further in view of Chien (GB 2227412A).

10. Referring to claims 7 and 35, Freitas et al. teach all of the limitations of these claims as described above except for the tool having a frangible portion or notch. Chien teaches a surgical instrument having a notched frangible portion 3. It would have been obvious to one of ordinary

skill in the art at the time of invention to include a frangible portion such as the notched portion in Chien to the device of Freitas et al. to ensure that the interchangeable tool of the device is not used again after it is removed from the coupler.

Response to Arguments

11. Applicant's arguments filed June 12, 2003 have been fully considered but they are not persuasive.

12. The applicant argues that the device of Freitas et al. does not read on the claims because the prime mover is not within the hollow manipulation shaft. However, the claims as presently worded only require that the shaft receive a prime mover. Figure 1 of Freitas et al. clearly shows that the mover 30 is received on the manipulation shaft inside the handle of the device.

13. The applicant states that a coupler having a lateral slot or hook shaped tine would not be an unpatentable design change to the Freitas et al. device. It is clear that imparting any such change on the device of Freitas et al. would in no way affect the functionality of the device and would be accurately described as design choices.

14. In response to applicant's argument that the device of Chien is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it is well known in the medical arts that making instruments disposable is an effective way to ensure that only sterile instruments are used on patients. Chien discloses an effective way to ensure that a medical instrument is used only once. It would have been obvious to one of ordinary skill in the art that the device of

Freitas et al. may be modified to incorporate the disposability features disclosed by Chien in order to ensure patient safety.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth G Schopfer whose telephone number is 703-305-2649. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

KS
July 30, 2003

MICHAEL PEFFLEY
PRIMARY EXAMINER